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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,072	11/30/1998	EDWARD LAWRENCE SINOFSKY	ROE-040C5	1102

7590 03/25/2002

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EXAMINER
SHAY, DAVID M

ART UNIT	PAPER NUMBER
3739	12

DATE MAILED: 03/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/201,072	Sinofsky
Examiner	**Group Art Unit**
D. Shay	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on December 14, 2001.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 44-57 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 44-57 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

The rejections set forth in the previous Office action are hereby repeated.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 45-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what, if any further structure is recited by stating the fiber is "suitable for coupling" to various lasers or "suitable for conducting" radiation of various pulse widths, pulse repetition rates, pulse energy, or suitable for various uses.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 44-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,159,203. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the instant claims are obvious change in scope relative to the patent claims.

5. Claims 44-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew in combination with Hicks, Jr. Dew teaches a device as claimed except for the particular composition. Hicks, Jr. teaches use of a low ~~hydroxylion~~ hydroxyl ion content fiber. It would have been obvious to the artisan of ordinary skill to employ the fiber of Hicks, Jr. in the device of Dew, since this fiber is designed to transmit the wavelength of Dew and to use a standard coupler and diameter for medical fibers, thereby rendering the fiber "suitable' for the various claimed uses, thus producing a device such as claimed.

6. The double patenting rejection has been repeated because the terminal disclaimer submitted December 14, 2001 is improper because it does not state the amount of interest the assignee has in the instant application.

a. Applicant's remarks regarding the phrases objected to by the examiner as unclear are noted. While the examiner notes that one skilled in the art would know how to make the end of a fiber suitable for conducting radiation, this is not the point. Quite simply, the conduction of radiation, for example is the raison d'etre of optical fibers. If an element is not suitable for the conduction of radiation, it cannot fairly be called an optical fiber. In fact if the element does not conduct radiation, or in other words if it is "unsuitable for conducting radiation" then it must be opaque and is unsuitable for use as any type of optical component other than a shutter or sheild. Similarly if the fibers were "unsuitable

for coupling" to the various types of lasers they would not be properly part of the surgical system as discribed and claimed.

b. Applicants comments relating to the Dew reference are noted but are not convincing. Dew discloses the use of 1.32 micron radiation as applicant admits (see instant response, the last sentence on page 3 thereof). Hicks Jr. teaches increasing the optical fibers transmission properties for radiation in this range. The examiner notes that it is notorious in the art that medical lasers are expensive; that the higher the power a laser is operated at the shorter its operating lifetime; the more radiation absorbed by an optical fiber, the hotter the fiber gets and the more likely the fiber will fail. To the extent that applicant is arguring that these realities were not known to the artisan of ordinary skill, the examiner takes official notice thereof. To extent that applicant is arguing that one having ordinary skill would not appreciate the economy of extended laser lifetime reduced cooling requirements for fiber instruments and reduced mortality due to catastrophic device failure or other causes such as reduced time under anesthesia in the event if non-catastrophic device failure, the examiner must disagree. In the same sense that those having ordinary skill in the art must be expected to undestand the requirements and limitations of optical fibers for proper operation in the surgical environment, as argued in the last three paragraph s on page 2 of the instant response, so must they understand the requirements of the lasers used therewith and the patients upon which the

surgery is performed. In view of this the examiner regards the combination of the references to be wholly proper and to read on applicant's claims.

7. Applicant's arguments filed December 14, 2001 have been fully considered but they are not persuasive.

8. This is a Request for Continued Examination of applicant's earlier Application No. 09/201,072. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Shay whose telephone number is (703) 308-2215. David Shay:bhw

March 20, 2002

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330